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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/641,709 | 08/21/2000 | Tsutomu Niwa | 36595:165795 | 8841 |

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EXAMINER

BROCKETTI, JULIE K

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 12/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,709

Applicant(s)

NIWA, TSUTOMU

Examiner

Julie K Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

1. Page 1 lines 13 and 14 do not make sense.
2. Page 2 lines 8 and 33 the word "an" should be "a".
3. Page 12 line 30 the word "t" should be "To".
4. Page 22 line 3 the word "roup" should be "group".

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 states "second notifying state determining means for determining and selecting in advance said current notifying states on the basis of said subsequent notifying states

determined by said subsequent notifying state determining means.” This is confusing and does not make sense. The claim is saying that the current notifying state is determined based on subsequent notifying states. This is not possible. One cannot determine something in the present based on something in the future. The claim is also in contradiction to claim 1 where the subsequent notifying states are determined based on the current notifying state.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman, U.S. Patent No. 4,624,459 in view of Ishibashi, U.S. Patent No. 5,695,188. Kaufman discloses a slot machine. The machine comprises shift and display means for shifting and displaying a plurality of rows. Each row having a plurality of symbols (Fig. 1). The game has a notifying means for notifying a game player of information including a current notifying state such as the display of symbols forming the gaming result. The game also includes a subsequent notifying state determining means for determining and selecting in

advance the subsequent notifying states in the current game based on the current notifying state that is informed to the player by the notifying means (col. 1 lines 51-67). For example, the player is notified of the current game state through the display of the combination of symbols after the reels have stopped. Based on whether or not this is a winning combination, the player is then informed of a multiple payout by the multiple payout indicator, i.e. subsequent notifying state. Consequently, the notifying information is correspondent to specified prize-winning state determined by the prize-winning state determining means at a predetermined probability. The prize-winning state could be a big or medium winning state (col. 3 lines 33-42). Kaufman discloses a token acceptor (col. 2 lines 51-52). It would have been obvious to have the notifying means operative to notify the game player of the notifying state determined by the subsequent notifying state determining means when a the current or subsequent game starts with a game medium inserted into the token accepting slot. Most games are started with the deposit of coins into a slot; consequently, it is obvious to start notifying players of their winnings once the game has been started. It would also have been obvious to have the current notifying state be identical to the subsequent notifying state and to continue to notify the game player of the identical notifying state without interruption. For example, if a player wins 1 game and then has to win 1 more to get the multiple payout. The multiple payout indicator could be displayed

during both games so that players are always informed that one more win will deliver a larger prize.

Ishibashi teaches of a gaming machine that determines a winning prize state based on a random number lottery. Stop control means control the stop of the reels based on the predetermined prize winning state (See Ishibashi col. 5 lines 35-48, 60-65; col. 8 lines 20-43). It would have been obvious at the time the invention was made to select the winning prize state by a random number lottery. It is well known throughout the art to use random numbers for selection of game outcomes. By randomly selecting a number, the game can be fair to all players. Ishibashi also teaches of a second notifying means in the form of sound. Sounds are used to notify a game player of notifying information in a current notifying state. The sounds are determined and selected in advance for broadcast to a player (See Ishibashi col. 8 lines 4-13). It would have been obvious at the time the invention was made to have a second notifying means so that players would clearly know the results of the prize.

Citation of Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Ishibashi, U.S. Patent No. 5,667,219.

--Ishibashi discloses a variable display gaming machine for displaying symbols in columns by moving each of the plurality of symbol columns separately in a predetermined direction.

2. Luciano, U.S. Patent No. 6,062,980.

--Luciano discloses a multi-stage wagering game in which two random outputs may be generated.

3. Piechowiak et al., U.S. Patent No. 6,168,523 B1.

--Piechowiak et al. discloses a gaming machine with a bonus award.

4. Brossard, U.S. Patent No. 6,302,790 B1.

--Brossard discloses a gaming device with audio and motion picture output.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-F 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.


JB

December 3, 2002



MICHAEL O'NEILL
PRIMARY EXAMINER